



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/127,059 07/31/98 LEONARDI

A 648/1D340-US

EXAMINER

BERNHARDT, E

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

07/14/00

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HM12/0714

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
09/127,059Applicant(s)
LEONARDI et al.Examiner
Emily BernhardtGroup Art Unit
1624**THE PERIOD FOR RESPONSE: [check only a) or b)]**

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jun 30, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

- ☒ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached response.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: 3, 19, and 20

Claims rejected: 1, 2, 4, 5, and 21

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

- ☒ Other PTO-892

EB
EMILY BERNHARDT
PRIMARY EXAMINER
ART UNIT 1624

Art Unit: 1624

ADVISORY ACTION

The amendment filed 6/30/00 cannot be entered for more than one reason. The narrower genus now presented for main claim 1 would require additional consideration and search as to patentability under 35 USC 102 and/or 103. At the very least the Plilai reference while no longer anticipatory in view of new proviso 4 in the new genus would be applicable under 35 USC 103 since the closest instant compounds embraced in previously anticipated claims would have an extra methyl group on phenyl ring in B and/or in Ar/Ar' rings and thus would be sufficiently similar to be held as obvious variants based on case law such as In re Wood 199 USPQ 137; In re Lohr 137 USPQ 548; In re Fauque 121 USPQ 425. Additionally the new definition for B rings would raise another description issue since the 2 examples mentioned in the specification are not enough to support rings of varying number and nature of hetero atoms in both rings of the fused ring systems. If the amendment were entered only #3 under par.two would be overcome.

Intended scope of "acyl" and "amido" would remain unclear. While applicants have presented

references showing these terms to be referring to carboxylic groups, it still is not known from applicants' specification what kind of groups are attached to the C(O) in acyl or amido or to the N atom in the amides. Alkyls? Alkenyls? Aryls? Heterocycles? Note however, Hackh's Dictionary provides a definition for these terms that is more extensive as other organic acid radicals for acyl and other organic amides for amido are given as examples. Thus these terms have varied and quite extensive meanings when viewed from differing sources which renders the scope indefinite and nonenabling.

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ADVISORY ACTION

Reason #2 under par.two as well would remain as well as corresponding rejection under par.one. The only atoms positively recited as ring members are N for the 5-membered ring and O for the 6-membered ring. "Containing" doesn't exclude other atoms as ring members. Where terms are not clearly defined in the specification they must be the given their broadest,reasonable meaning. Note last paragraph,right column on p.423 of In re Wiggins 179 USPQ 421.

The new matter rejection would still remain for the newly amended B group as discussed above. The Ward reference would no longer be applicable against claims 1,2,4 and 5 but would remain for claim 21 for reason given previously. Pilai would no longer anticipate the claims in view of the new proviso in claim 1 but would be applicable under 103 as discussed above. Note the typographical in the new proviso- Y should be "CH".

Nonelected subject matter still remains and needs to be cancelled or other appropriate action taken as indicated in the final rejection.

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

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